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MINNEAPOLIS, MN 55440-1022

EXAMINER
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SPISICH, MARK

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3727

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/036,022  
Filing Date: December 26, 2001  
Appellant(s): ROBERTS ET AL.

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Celia H. Leber  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 8 December 2008 appealing from the Office action mailed 19 September 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Agreement with appellant's statement of related appeals.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed. All amendments have been entered.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 52-54 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 1-72128 (hereinafter '128). '128 discloses an oral brush comprising an elongated handle (3), head portion (1) as well as a brush portion comprising at least one elastomeric element (2) comprising a styrenic block copolymer (see page 6 of exhibit "B" filed 4 October 2004 and page 4 of the translation filed by appellant with the foreign document) thermoplastic elastomer and further including conventional non-elastomeric bristles in a center portion of the head (see page 5, line 28 of the translation attached to '128) with the elastomeric bristles/elements being at the side portions of the brush portion (claim 3). '128 discloses the invention substantially as claimed with the exception of the Shore A hardness being "less than 55" and (at least argued by appellant) the fact that the elastomeric element is "molded". The example in the specification for the preferred material in the recited category is a known material (KRATON, page 7, line 1). It is not unreasonable to assume that an elastomer in this class of materials having the recited hardness exists under the trademark KRATON. The issue of the hardness would be more critical if the prior art applicant against the claim(s) was for a totally different use and wherein the properties of the material would

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arguably be much different than that useful in the claimed environment (oral brush).

This is not true in the present case. The prior art device is also had the same use and provides the elastomeric element(s) for much the same reason as in the claimed invention. It would not take any undue experimentation to determine which degree of hardness would be appropriate for use in a user's mouth. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select a material (such a KRATON) or another thermoplastic elastomer falling within the basic parameters of '128 having an appropriate hardness, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With regard to the term "molded", the materials of the present application are also extruded or molded. In addition, the present specification (eg, page 3, lines 21-25) describes the category of materials known as "thermoplastic elastomers" as materials which can be processed by conventional plastics processing methods which are well known in the art, such as extrusion or injection molding. These same disclosed materials may also be formed by extrusion, whereby the filaments are placed under tension during manufacture thereof (page 9, lines 16-29). The particular manner of forming the "element", in an apparatus claim, is not as significant as if the claim were drawn to a method of forming or manufacture thereof. The present applicant discloses that these same materials can be formed by any number of processes and still result in the same product.

**(10) Response to Argument**

Most of applicant's remarks deal with the term "molded". With regard to the hardness, the prior art discloses an elastomeric element(s) in an oral brush "providing a soft feel against the gums, etc., providing comfortable cleaning and massaging action (see the '128 translation: page 5, lines 6-8). The brush of '128 and the present application are both used in the same environment and the elastomeric elements in '128 are provided for essentially the same reason as that of the present application. The selection of a known material (of the class of materials disclosed in '128) having properties that would be comfortable to a particular user would be easily arrived at through routine experimentation. The remaining comments apply to the term "molded". The basic elements of the claimed invention (as recited in claim 52) is disclosed in the prior art (JP '128). That being a handle (3), head (1) and brush portion including a plurality of elastomeric elements (2) which may be a styrenic block copolymer (see page 4 of the attached translation) and further including a plurality of conventional non-elastomeric bristles (see page 5, line 28 thru page 6, line 4). Appellant argues that the prior art (JP '128) fails to disclose that the elastomer element is "molded". Appellant (on page 3, lines 20-21 of the brief) states that "all of the elastomeric bristles disclosed in the '128 utility model are melt spun, or melt spun and drawn (i.e. stretched)". Appellant (and the members of the Board) is directed to page 9 (lines 16-29) and figure 5 of the present specification which recites in detail one manner of forming the elastomeric elements of the present application. This states that the elastomer elements may be formed by extrusion and drawing (i.e. stretching). The present application is mostly

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concerned with the use of a thermoplastic elastomer element in an oral brush and provides a number of preferred materials (including the presently recited styrenic block copolymer). These materials are described by appellant (specification: page 3, lines 21-25) as materials which may be processed by conventional plastics processing methods which are well known in the art, such as extrusion or injection molding. The Board is reminded that the claim(s) of the instant application are drawn to a product/apparatus and not to a method of manufacture. Looking to appellant's own specification, the same elastomeric element(s) may be formed in any number of ways. There is no hint in the specification that one use a particular process to form an element structurally different from one produced by another of the disclosed methods. Applicants position that there is no way you would want to extrude and draw the elastomer elements is not understood since page 5 of the present application discloses such a manner of forming them. With regard to the reference to the prior rule 1.132 declaration of Craig Masterman, Mr. Masterman alleged that molding the elastomeric elements produce superior properties. Appellant is simply claiming (claim 52) that the element(s) is a styrenic block copolymer that is molded. As the claims are drawn to a product/apparatus, appellant's own specification (as well as the remarks on page 4 of the brief) states that the elements could in fact be formed by either extruding or molding. The disclosure of these different techniques is presented in a manner to suggest that the different processes are interchangeable and that each of the various preferred materials could be formed in any desired and known manner. As such, the recitation of

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"molding" in the claim is germane only to the manner of forming the element and not to the product itself.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mark Spisich

/Mark Spisich/

Primary Examiner, Art Unit 3727

Conferees:

/Monica S. Carter/

Supervisory Patent Examiner, Art Unit 3727

/Robin O. Evans/

TQAS, Technology Center 3700